

103^D CONGRESS
2^D SESSION

S. 1854

To amend the provisions of title 35, United States Code, to provide for patent simplification.

IN THE SENATE OF THE UNITED STATES

FEBRUARY 11 (legislative day, JANUARY 25), 1994

Mr. DECONCINI introduced the following bill; which was read twice and referred to the Committee on the Judiciary

A BILL

To amend the provisions of title 35, United States Code, to provide for patent simplification.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Patent Term and Pub-
5 lication Reform Act of 1994”.

6 **SEC. 2. PATENT SIMPLIFICATION.**

7 (a) DEFINITION.—Section 100 of title 35, United
8 States Code, is amended by adding at the end thereof the
9 following:

1 “(e) The term ‘filing date’ means the earliest of the
2 actual filing date or any priority date claimed by the appli-
3 cant under section 119, 120, or 365.’”.

4 (b) CONDITIONS FOR PATENTABILITY; NOVELTY AND
5 LOSS OF RIGHT TO PATENT.—Section 102(e) of title 35,
6 United States Code, is amended to read as follows:

7 “(e) the invention was described in—

8 “(1) a published patent application,

9 “(2) a patent granted on an application for pat-
10 ent by another filed in the United States before the
11 invention thereof by the applicant for patent, or

12 “(3) in an international application that—

13 “(A) is filed by another before the inven-
14 tion thereof by the applicant for patent, and

15 “(B) enters the national stage under sec-
16 tion 371, or”.

17 (c) BENEFIT OF EARLIER FILING DATE; RIGHT OF
18 PRIORITY.—(1) Section 119 of title 35, United States
19 Code, is amended—

20 (A) in the section heading by striking out “**in**
21 **foreign country**”;

22 (B) by designating the first, second, third, and
23 fourth undesignated paragraphs as subsections (a),
24 (c), (d), and (e), respectively; and

1 (C) by inserting after subsection (a) (as des-
2 ignated by subparagraph (B) of this paragraph) the
3 following new subsection:

4 “(b)(1) An application for patent for an invention de-
5 scribed in paragraph (2) that is filed by an inventor named
6 in the previously filed application described under para-
7 graph (2), shall have the same effect, as to such invention,
8 as if such application had been filed on the filing date of
9 the previously filed application, if such application—

10 “(A) is filed within one year after the filing
11 date of the previously filed application (or earlier
12 priority date); and

13 “(B)(i) contains a specific reference to the pre-
14 viously filed application; or

15 “(ii) within three months after the actual filing
16 date of such application, is amended to contain—

17 “(I) a specific reference to the previously
18 filed application; or

19 “(II) such other item as the Commissioner
20 may prescribe.

21 “(2) An invention referred to under paragraph (1)
22 is an invention that is disclosed—

23 “(A) in the specification as provided under sec-
24 tion 112 in an application filed in the United States

1 before the application described under paragraph (1)
2 is filed; or

3 “(B) as provided under section 363.”.

4 (2) The table of sections for chapter 11 of title 35,
5 United States Code, is amended in the item relating to
6 section 119 by striking out “in foreign country”.

7 (d) BENEFIT OF EARLIER FILING DATE IN THE
8 UNITED STATES.—Section 120 of title 35, United States
9 Code, is amended to read as follows:

10 **“§ 120. Benefit of earlier filing date in the United**
11 **States**

12 “(a) An application for patent for an invention de-
13 scribed under subsection (b) that is filed by an inventor
14 named in the previously filed application described under
15 subsection (b), shall have the same effect, as to such in-
16 vention, as if such application had been filed on the filing
17 date of the previously filed application, if such applica-
18 tion—

19 “(1) is filed before the patenting, abandonment
20 of, or termination of proceedings on—

21 “(A) the previously filed application; or

22 “(B) an application similarly entitled to
23 the benefit of the filing date of the previously
24 filed application;

1 “(2) is not otherwise entitled to a priority right
2 under section 119(b); and

3 “(3)(A) contains a specific reference to the pre-
4 viously filed application; or

5 “(B) within fifteen months after the actual fil-
6 ing date of such application, is amended to con-
7 tain—

8 “(i) a specific reference to the previously
9 filed application; or

10 “(ii) such other item as the Commissioner
11 may prescribe.

12 “(b) An invention referred to under subsection (a) is
13 an invention that is disclosed—

14 “(1) in the specification as provided under sec-
15 tion 112 in an application filed in the United States
16 before the application described under subsection (a)
17 is filed; or

18 “(2) as provided under section 363.”.

19 (e) OPENING OF PATENT APPLICATIONS; CONFIDEN-
20 TIAL STATUS.—(1) Section 122 of title 35, United States
21 Code, is amended to read as follows:

22 **“§ 122. Opening of patent applications; confidential**
23 **status**

24 “(a) Except as provided under subsection (b), appli-
25 cations for patents shall be kept in confidence by the Pat-

ent and Trademark Office and no information concerning such applications may be disclosed.

“(b) On and after the date occurring 18 months after the filing date of an application for patent (including all priority claims) each application for patent shall be open to public inspection and copies shall be made available to the public under such procedures as may be determined by the Commissioner, except—

“(1) an application may be made so available during such 18-month period if confidentiality is waived by the applicant; and

“(2) an application may be maintained in secrecy under any order under chapter 17.

“(c) The Commissioner shall publish each patent application promptly when open to public inspection under subsection (b).”.

(2) The table of sections for chapter 11 of title 35, United States Code, is amended by amending the item relating to section 122 to read as follows:

“122. Opening of patent applications; confidential status.”.

(f) CONTENTS AND TERM OF PATENT.—Section 154 of title 35, United States Code, is amended to read as follows:

“§ 154. Contents and term of patent

“(a)(1) Subject to the provisions of paragraph (2), every patent shall contain—

1 “(A) a short title of the invention;

2 “(B) a grant to the patentee, and the heirs or
3 assigns of the patentee—

4 “(i) for a term beginning on the date on
5 which the patent is issued and ending on a date
6 20 years from the date on which the application
7 for patent is filed in the United States, exclud-
8 ing any claims of priority under section 119 or
9 365;

10 “(ii) of the right to exclude others from
11 making, using, or selling the invention through-
12 out the United States or importing the inven-
13 tion into the United States;

14 “(iii) if the invention is a process, of the
15 right to exclude others from using or selling
16 throughout the United States, or importing into
17 the United States, products made by that proc-
18 ess; and

19 “(iv) that refers to the specification for the
20 particulars of the invention; and

21 “(C) a copy of the specification and drawings
22 which shall be annexed to the patent and be a part
23 of the patent.

24 “(2) The grant of a patent shall be subject to the
25 payment of fees as provided by this title.

1 “(b)(1) In addition to the contents described under
2 subsection (a), the grant of a patent described under para-
3 graph (2) shall additionally include the right to obtain a
4 reasonable royalty from any other person who, during the
5 period before the grant—

6 “(A)(i) makes, uses, or sells the claimed inven-
7 tion in the United States, or imports the claimed in-
8 vention into the United States; or

9 “(ii) if the claimed invention is a process, uses
10 or sells throughout the United States or imports into
11 the United States products made by that process;
12 and

13 “(B) had actual knowledge of the published ap-
14 plication.

15 “(2) Paragraph (1) applies to any patent—

16 “(A) that is granted based on an application
17 published under section 122(c) before such patent is
18 granted; and

19 “(B) to the extent the patent claims in the is-
20 sued patent are substantially identical with the
21 claims in such published application.”.

22 (g) TERM OF DESIGN PATENT.—Section 173 of title
23 35, United States Code, is amended by striking out “four-
24 teen years.” and inserting in lieu thereof “seventeen years

1 from the filing date, as determined under section 154(a)
2 of this title.”.

3 **SEC. 3. EFFECTIVE DATE AND APPLICABILITY.**

4 The provisions of this Act and the amendments made
5 by this Act shall take effect 90 days after the date of the
6 enactment of this Act and shall apply only to applications
7 filed on and after such effective date.

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